



IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Henry, et al.

Confirmation No.: 2499

Application No.: 09/576,093

Examiner: Eng, David

Filing Date: 5-22-00

Group Art Unit: 2155

Title: Information Caching System and Method

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in **triplicate** is the Appeal Brief in this application with respect to the Notice of Appeal filed on July 30, 2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$110.00
() two months	\$420.00
() three months	\$950.00
() four months	\$1480.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$330.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

() I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, Alexandria, VA
22313-1450. Date of Deposit: 9-28-04

OR

() I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number _____ on _____

Number of pages:

Typed Name: Mary Meegan

Signature: Mary Meegan

Respectfully submitted,

Henry, et al.

By David Rodack

David Rodack, Esq.

Attorney/Agent for Applicant(s)

Reg. No. 47,034

Date: 9-28-04

Telephone No.: (770) 933-9500



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Henry, et al.

Serial No.: 09/576,093

Filed: May 22, 2000

Group Art Unit: 2155

Examiner: Eng, David Y

Docket No. 10002031-1

For: Information Caching System and Method

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Brief; Commissioner for Patents, U.S. Patent & Trademark Office, P.O. Box 1450 Alexandria, Virginia 22313-1450, on 9-28-04.

Signature –

Mary Megan

APPEAL BRIEF UNDER 37 C.F.R. §1.192

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the decision of Examiner David Y. Eng, Group Art Unit 2499, mailed 7/15/2004, rejecting claims 1, 5-10, 12-24, and 30 in the present application and making the rejection FINAL.

I. REAL PARTY IN INTEREST

The real party in interest of the instant application is Hewlett-Packard Development Company, a Texas Limited Liability Partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 1, 5-10, 12-24, and 30 are pending in the application. In a final Office Action mailed 3/31/2004, claims 1, 4-24 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nielson* (U.S. Pat. No. 6,405,243) in view of *Reilly* (U.S. Pat. No. 6,427,164).

A response with amendments to the final Office Action was mailed on 5/18/04, prompting an advisory action mailed on 7/15/2004. The advisory action entered the amendments, and indicated that the reply failed to place the application in condition for allowance. For the reasons set further herein, Applicants respectfully request that these rejections be overturned.

IV. STATUS OF AMENDMENTS

Amendments have been made since the mailing of the FINAL Office Action and all amendments submitted prior to and after the FINAL Office Action have been entered. A copy of the current claims is attached hereto as Exhibit A.

V. SUMMARY OF CLAIMED SUBJECT MATTER

With regard to independent claim 1, Applicants claim (with Figure 3 reference numerals inserted in parentheses):

1. A method for processing sending information in a sending device, comprising:
receiving an entry input by a user at the sending device, the entry comprising sending information that identifies a destination to which information is to be sent by the sending device (302);

responsive to the entry, cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the contacts database (304), wherein the contacts database is stored within memory of the sending device; and

automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved (308).

An operation panel of a sending device is described in association with FIG. 1. The specification provides on page 4, lines 15-20 the following explanation with regard to FIG. 1:

FIG. 1 illustrates an operation panel 10 of a sending device of the type in which the present invention can be utilized. As indicated in this figure, the operation panel 10 can generally include a display 12 and a keyboard 14.

On page 5, lines 7-11, the specification provides the following explanation for a sending device:

Although a sending device is described herein by way of example, it is to be understood that the application of the present invention is not limited to such sending devices, but also includes use in substantially any device that is used to transmit information to an e-mail address and/or a fax number. Accordingly, the principles of the present invention apply equally to fax machines as well as e-mail programs generally.

The method steps described in claim 1 are further described on page 7, lines 5-12:

After the user has logged in, he or she can enter an e-mail address or fax number as indicated in block 302. After the address or number has been entered by the user, the system determines whether that address or number has previously been saved in that particular user's address book within the device memory. As indicated at 304, if the address or number matches one that has already been entered by the user, the address or number is not saved, as indicated at block 306. If, on the other hand, the entered address or number does not match any such addresses or numbers stored in the user's address book, the entered address or number is saved to the user's address book as indicated in block 308.

The contacts database (corresponding to user's address book) is stored in memory, as shown in FIG. 2 and described on page 5, lines 15-17 in addition to the description provided above.

The specification provides on page 5, lines 15-17 as follows:

Typically, the memory 102 includes, inter alia, a caching system 104, as well as an operating system 106. If, as indicated in FIG. 1, the sending device 10 includes a

keyboard 14, the input device 110 can comprise one or more of the keys of this keyboard 14.

Thus, several features are clear from the claims as supported by the specification. The entry, whether it is an email address or fax number, is entered at the sending device. Also, the cross referencing to a contacts database occurs in response to a user entering the email address at the sending device. In addition, the contacts database is stored in memory of the sending device. Finally, the caching is automatic when it is determined that the number or address has not previously been saved to the contacts database.

With regard to independent claim 9, Applicants claim (with Figures 3 and 4 references inserted in parentheses):

9. A method for processing sending information in a sending device, comprising:
 - receiving an entry input by a user at the sending device, the entry comprising sending information (302), and determining the identity of the user from the entry (400);
 - receiving the sending information entered by the user that identifies a destination to which information is to be sent by the sending device (302);
 - responsive to the entry, cross-referencing the sending information entered by the user with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved for that user (304), wherein the contacts database is stored within memory of the sending device;
 - providing previously saved sending information to the user as a selection option if sending information entered by the user matches the previously saved sending information (406, 410); and
 - automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved (308).

An operation panel of a sending device is described in association with FIG. 1. The specification provides on page 4, lines 15-20 the following explanation with regard to FIG. 1:

FIG. 1 illustrates an operation panel 10 of a sending device of the type in which the present invention can be utilized. As indicated in this figure, the operation panel 10 can generally include a display 12 and a keyboard 14.

On page 5, lines 7-11, the specification provides the following explanation for a sending device:

Although a sending device is described herein by way of example, it is to be understood that the application of the present invention is not limited to such sending devices, but also includes use in substantially any device that is used to transmit information to an e-mail address and/or a fax number. Accordingly, the principles of the present invention apply equally to fax machines as well as e-mail programs generally.

The method steps described in claim 9 are further described on page 7, lines 5-12 (corresponding to FIG. 3):

After the user has logged in, he or she can enter an e-mail address or fax number as indicated in block 302. After the address or number has been entered by the user, the system determines whether that address or number has previously been saved in that particular user's address book within the device memory. As indicated at 304, if the address or number matches one that has already been entered by the user, the address or number is not saved, as indicated at block 306. If, on the other hand, the entered address or number does not match any such addresses or numbers stored in the user's address book, the entered address or number is saved to the user's address book as indicated in block 308.

The contacts database (corresponding to user's address book) is stored in memory, as shown in FIG. 2 and described on page 5, lines 15-17 in addition to the description provided above.

The specification provides on page 5, lines 15-17 as follows:

Typically, the memory 102 includes, inter alia, a caching system 104, as well as an operating system 106. If, as indicated in FIG. 1, the sending device 10 includes a keyboard 14, the input device 110 can comprise one or more of the keys of this keyboard 14.

With regard to the FIG. 4 method steps, the specification provides support on page 8, line 13 through page 9, line 7, as follows:

FIG. 4 provides a flow diagram illustrating a sending procedure used by a sending device user in accordance with the principles of the present invention. As indicated in this figure, the user logs into the sending device at block 400. Once logged in, the user is permitted to either call up a saved address, number, or distribution list from his or her address book as indicated at block 402. If the user does not choose to select such an address, number, or list in this manner, he or she can begin to enter the destination e-mail address, fax number, or list name to which the document will be transmitted as indicated at block 404. While the user is entering the address, the system cross-references with the user's address book to determine whether or not the partially entered address/number or list

name matches any such address number or list name saved in the user's address book as in block 406. If not, the user will complete the address or fax number being entered, and will have the opportunity to enter further addresses/numbers or lists as indicated at block 408. If, however, the system recognizes the partially entered address/number or list, the system will automatically pull up the matching address/number or list, as indicated in block 410, as an option for the user to select.

The log-in is further supported for the flow diagram described in FIG. 3 on pages 6-7, lines 19-5, which provides as follows:

With reference to FIG. 3, a sending information caching process in accordance with the principles of the present invention will be discussed. As indicated at block 300, the user first logs into the sending device, by way of example, by both entering a user name as well as a password. In the office environment, this user name and password will be either assigned to or selected by each employee that will be permitted to use the sending device. If desired, an office administrator can be selected to maintain records of each person's user name and password.

Thus, several features are clear from the claims as supported by the specification. The entry, whether it is an email address or fax number, is entered at the sending device and the log-in operation enables a determination of the identity of the user. Also, the cross referencing to a contacts database occurs in response to a user entering the email address at the sending device. In addition, the contacts database is stored in memory of the sending device. Also, previously saved sending information is presented when the user is entering sending information. Finally, the caching is automatic when it is determined that the number or address has not previously been saved to the contacts database.

With regard to independent claim 15, Applicants claim (with Figures 2 and 3 references inserted in parentheses):

15. A sending information processing system, comprising:

logic (104) configured to receive sending information entered by a user at a sending device that identifies a destination to which electrical information is to be sent (302);

logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database (104) that contains recipient sending information of the user to determine if the user-entered sending information

matches sending information saved for that user in the database (304), wherein the contacts database is stored within memory (102) of the sending device; and

logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved (308).

An operation panel of a sending device is described in association with FIG. 1. The specification provides on page 4, lines 15-20 the following explanation with regard to FIG. 1:

FIG. 1 illustrates an operation panel 10 of a sending device of the type in which the present invention can be utilized. As indicated in this figure, the operation panel 10 can generally include a display 12 and a keyboard 14.

On page 5, lines 7-11, the specification provides the following explanation for a sending device:

Although a sending device is described herein by way of example, it is to be understood that the application of the present invention is not limited to such sending devices, but also includes use in substantially any device that is used to transmit information to an e-mail address and/or a fax number. Accordingly, the principles of the present invention apply equally to fax machines as well as e-mail programs generally.

The system limitations described in claim 15 have functionality that is described on page 7, lines 5-12 corresponding to the method flow diagram of FIG. 3:

After the user has logged in, he or she can enter an e-mail address or fax number as indicated in block 302. After the address or number has been entered by the user, the system determines whether that address or number has previously been saved in that particular user's address book within the device memory. As indicated at 304, if the address or number matches one that has already been entered by the user, the address or number is not saved, as indicated at block 306. If, on the other hand, the entered address or number does not match any such addresses or numbers stored in the user's address book, the entered address or number is saved to the user's address book as indicated in block 308.

The contacts database (corresponding to user's address book) is stored in memory, as shown in FIG. 2 and described on page 5, lines 15-17 in addition to the description provided above.

The specification provides on page 5, lines 15-17 as follows:

Typically, the memory 102 includes, inter alia, a caching system 104, as well as an operating system 106. If, as indicated in FIG. 1, the sending device 10 includes a

keyboard 14, the input device 110 can comprise one or more of the keys of this keyboard 14.

This portion of the specification also indicates that the functionality described in FIG. 3 (and in claim 15) is provided via logic provided in the caching system (caching system 104). Thus, several features are clear from the claims as supported by the specification. The entry, whether it is an email address or fax number, is entered at the sending device. Also, the cross referencing to a contacts database occurs in response to a user entering the email address at the sending device. In addition, the contacts database is stored in memory of the sending device. Finally, the caching is automatic when it is determined that the number or address has not previously been saved to the contacts database.

With regard to independent claim 20, Applicants claim (with Figures 2 and 3 references inserted in parentheses):

20. A sending information processing system, comprising:
- means for receiving (10) through entry by a user at a sending device sending information that indicates a destination to which information is to be sent (302);
 - means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the database for that user (304), wherein the contacts database is stored within memory of the sending device; and
 - means for automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved (308).

An operation panel 10 of a sending device is described in association with FIGS. 1 and 2, and in particular, components of the operation panel relevant to claim 20 are described in association with FIG. 2. The means-for functionality of claim 20 are provided by the logic corresponding to the caching system 104, the processor 100, the operating system 106, the input device 110, and the local interface 108. The specification provides on page 4, lines 15-20 the following explanation with regard to FIG. 1:

FIG. 1 illustrates an operation panel 10 of a sending device of the type in which the present invention can be utilized. As indicated in this figure, the operation panel 10 can generally include a display 12 and a keyboard 14.

On page 5, lines 7-11, the specification provides the following explanation for a sending device:

Although a sending device is described herein by way of example, it is to be understood that the application of the present invention is not limited to such sending devices, but also includes use in substantially any device that is used to transmit information to an e-mail address and/or a fax number. Accordingly, the principles of the present invention apply equally to fax machines as well as e-mail programs generally.

The means-for system limitations described in claim 20 have functionality that is described on page 7, lines 5-12 corresponding to the method flow diagram of FIG. 3:

After the user has logged in, he or she can enter an e-mail address or fax number as indicated in block 302. After the address or number has been entered by the user, the system determines whether that address or number has previously been saved in that particular user's address book within the device memory. As indicated at 304, if the address or number matches one that has already been entered by the user, the address or number is not saved, as indicated at block 306. If, on the other hand, the entered address or number does not match any such addresses or numbers stored in the user's address book, the entered address or number is saved to the user's address book as indicated in block 308.

The contacts database (corresponding to user's address book) is stored in memory, as shown in FIG. 2 and described on page 5, lines 15-17 in addition to the description provided above.

The specification provides on page 5, lines 15-17 as follows:

Typically, the memory 102 includes, inter alia, a caching system 104, as well as an operating system 106. If, as indicated in FIG. 1, the sending device 10 includes a keyboard 14, the input device 110 can comprise one or more of the keys of this keyboard 14.

This portion of the specification also indicates that the functionality described in FIG. 3 (and in claim 20) is provided via logic provided in the caching system (caching system 104) and other components of the system 10 (FIG. 2). Thus, several features are clear from the claims as supported by the specification. The entry, whether it is an email address or fax number, is entered at the sending device. Also, the cross referencing to a contacts database occurs in response to a user entering the email address at the sending device. In addition, the contacts database is stored in memory of the sending device. Finally, the caching is automatic when it is determined that the number or address has not previously been saved to the contacts database.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 5-10, 12-24, and 30 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Nielson* (U.S. Pat. No. 6,405,243) in view of *Reilly* (U.S. Pat. No. 6,427,164).

VII. ARGUMENT

Discussion of Independent Claim 1 and Dependent Claims 5-8 and 30

In the present case, it is respectfully asserted that not every feature of the claimed invention is represented in the combination of the *Nielson* and *Reilly* references. In particular, neither *Nielson* nor *Reilly*, alone or in combination, disclose, teach, or suggest the claim limitations “responsive to the entry, cross-referencing the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “automatically caching the user-entered sending information in the

contacts database if the user-entered sending information has not been previously saved,” as recited in claim 1. The final Office Action alleged that *Nielson* teaches the “responsive to the entry, cross-referencing the user-entered sending information with a contacts database” limitation, as noted below:

responsive to the entry, cross-referencing (see steps 501, 503 and 505 in Figure 5) the user-entered sending information with a contacts database (see Book File in step 501) that contains recipient sending information of the user to determine (step 505) if the user-entered sending information matches sending information saved in the contacts database;

In the communication filed on 2/2/2004, Applicants contended that the cross referencing in *Nielson* does not occur responsive to the entry. The Examiner disagrees. *Nielson*’s system is for forwarding email message (see the first sentence in abstract). In fact, all the procedures in *Nielson* are initiated when a user enters a sending message to be forwarded to a destination address. See the procedure in Figure 5 for example. The procedure in Figure 5 is initiated when a user enters sending information.

Applicants respectfully disagree. The lack of explicit support (*i.e.*, since the Office Action is alleging an inherency argument) for the Office Action’s assertion of a user entry at the sending device obscures the circumstances that occur post-entry. In other words, it is not clear from the *Nielson* reference what occurs in “response to” the alleged entry input. Nor is it clear what prompts steps 501 and 503, as the specification in *Nielson* fails to inform one skilled in the art what “BEGIN” actually entails. For example, Applicants respectfully inquire where in the specification is there support for the statement, “The procedure in Figure 5 is initiated when a user enters sending information.” Applicants have included a portion of the specification (see col. 7, lines 15-25) pertaining to FIG. 5 below:

FIG. 5 illustrates the preferred steps for updating the sender’s address book with the recipient’s new email address. In step 501, the method retrieves the sender’s address-book. In step 503, the method searches the retrieved address-book for the recipient’s old email address. If not found (step 505), the method adds the recipient’s new email address to the address book (step 507). If found (step 505), the method replaces the recipient’s old email address with the

recipient's new email address (step 509). Upon completion of steps 507 or 509, processing ends in the method of FIG. 5.

There is no mention that the cross referencing is responsive to an entry input. It is unclear from this excerpt what prompts the process illustrated in FIG. 5.

With regard to the limitation of claim 1, "wherein the contacts database is stored within memory of the sending device," the final Office Action alleged the following:

Although Nielson refers to the address book as the sender's address book in lines 10-14 of column 7, Nielson does not explicitly state that the sender address book is stored in the sender's sending device. Reilly teaches a sender's address book which is stored in a sending device 110 (see lines 54-58 of column 9 in Reilly). From the teaching of Reilly, it would have been obvious to a person of ordinary skill in the art to store a sender's address book in a sending device such that the address book can be used by the sending machine.

Applicants respectfully submit that the proposed combination would render the invention in *Nielson* unsatisfactory for its intended purpose, and thus the combination of references is improper. The system described in *Nielson* is for updating email addresses. (See col. 1, lines 5-6) This is accomplished through a network-based, address-change server that maintains a database to perform a cross-reference from an old email address to a new email address (See col. 1 and 2, Summary of the Invention). Maintaining such a database at each sending device is not suggested in *Nielson*, and in fact, even prior art systems rely on a centric-database system (e.g., controlled by a system administrator, as described in Col. 1, Background of the Invention). Maintaining the database of *Nielson* at each sending device would cause error messages to occur when email addresses are changed, creating the very problem the invention in *Nielson* seeks to address.

With regard to the limitation of “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” the final Office Action alleged that *Nielson* discloses this limitation:

automatically caching the user-entered sending information in the contacts database (see step 507) if the user-entered sending information has not been previously saved.

Applicants respectfully disagree. Step 507 provides, with emphasis added, “the method adds the recipient’s **new email address** to the address book.” (See col. 7, lines 20-21) The new email address is not **the** sending information entered at the sending device. Note the antecedent basis of the sending information in claim 1. Assuming the inherency of an entry is true, it would be the **recipient’s old email address, not the new email address** that is entered, as supported in the final Office Action:

Receiving (see “BEGIN” in Figure 5) an entry (email message containing recipient’s old email address, inherent from step 503) input by a user...

Thus, according to the explicit limitations in claim 1, the sending information entered at the sending device is what is automatically cached. The final Office Action correlated the **sending information** with the recipient’s **old email address** allegedly “entered” at a sending device. This old email address, if not saved already, must be the sending information automatically cached to meet the explicit claim limitations of claim 1. The invention disclosed in *Nielson* does not teach this feature.

Thus, since neither *Nielson* nor *Reilly* disclose, teach, or suggest the claim limitations “responsive to the entry, cross-referencing the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “automatically caching the user-entered sending information in the contacts

database if the user-entered sending information has not been previously saved,” Applicants respectfully request that the rejection to claim 1 be withdrawn.

Applicants also submit that since independent claim 1 is allowable, dependent claims 5-8 and 30, which contain the limitations of independent claim 1, is allowable as a matter of law.

Discussion of Independent Claim 9 and Dependent Claims 10 and 12-14

With regard to independent claim 9, neither *Nielson* nor *Reilly*, alone or in combination, disclose, teach, or suggest the claim limitations “responsive to the entry, cross-referencing the sending information entered by the user with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” as recited in claim 9. The final Office Action alleged that *Nielson* teaches the limitation of “cross-referencing the sending information entered by the user with a contacts database.” Applicants respectfully disagree. It is not clear from the *Nielson* reference what occurs in “response to” the “inherent” entry input. Nor is it clear what prompts steps 501 and 503, as the specification in *Nielson* fails to inform one skilled in the art what “BEGIN” means.

With regard to the limitation of claim 9, “wherein the contacts database is stored within memory of the sending device,” Applicants respectfully submit that the combination of *Nielson* and *Reilly* is improper in that such a combination would render the invention in *Nielson* unsatisfactory for its intended purpose. Maintaining the database of *Nielson* at each sending device would cause error messages to occur when email addresses are changed, creating the very problem the invention in *Nielson* sought to address

With regard to the limitation, “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” Applicants respectfully submit that this limitation is not disclosed, taught, or suggested in the combined references. Step 507 provides, with emphasis added, “the method adds the recipient’s **new email address** to the address book.” (See col. 7, lines 20-21)

The new email address is not **the** sending information entered at the sending device. Thus, according to the explicit limitations in claim 9, the sending information entered at the sending device is what is automatically cached. The final Office Action correlates the sending information with the recipient’s old email address allegedly “entered” at a sending device. This old email address, if not saved already, must be the sending information automatically cached to meet the explicit claim limitations of claim 9. The invention disclosed in *Nielson* does not teach this feature.

Thus, since neither *Nielson* nor *Reilly* disclose, teach, or suggest the claim limitations “responsive to the entry, cross-referencing the sending information entered by the user with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” Applicants respectfully request that the rejection to claim 9 be withdrawn.

Applicants also submit that since independent claim 9 is allowable, dependent claims 10 and 12-14, which contain the limitations of independent claim 9, is allowable as a matter of law.

Discussion of Independent Claim 15 and Dependent Claims 16-19

With regard to independent claim 15, neither *Nielson* nor *Reilly*, alone or in combination, disclose, teach, or suggest the claim limitation “logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” as recited in claim 15. The final Office Action alleged that *Nielson* teaches the limitation, “logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database.” Applicants respectfully disagree. It is not clear from the *Nielson* reference what occurs in “response to” the “inherent” entry input, nor is it clear what prompts steps 501 and 503. The specification in *Nielson* fails to teach one skilled in the art what “BEGIN” actually entails.

With regard to the limitation of claim 15, “wherein the contacts database is stored within memory of the sending device,” Applicants respectfully submit that the combination of *Nielson* and *Reilly* is improper in that such a combination would render the invention in *Nielson* unsatisfactory for its intended purpose. Maintaining the database of *Nielson* at each sending device would cause error messages to occur when email addresses are changed, creating the very problem the invention in *Nielson* sought to address.

With regard to the limitation, “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” Applicants respectfully submit that this limitation is not disclosed, taught, or suggested in the combined references. Step 507 provides, with emphasis added, “the method adds the recipient’s **new email address** to the address book.” (See col. 7, lines 20-21)

The new email address is not **the** sending information entered at the sending device. Thus, according to the explicit limitations in claim 15, the sending information entered at the sending device must be what is automatically cached. The invention disclosed in *Nielson* does not teach this feature.

Thus, since neither *Nielson* nor *Reilly* disclose, teach, or suggest the claim limitations “logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” Applicants respectfully request that the rejection to claim 15 be withdrawn.

Applicants also submit that since independent claim 15 is allowable, dependent claims 16-19, which contain the limitations of independent claim 15, are allowable as a matter of law.

Discussion of Independent Claim 20 and Dependent Claims 21-24

With regard to independent claim 20, neither *Nielson* nor *Reilly*, alone or in combination, disclose, teach, or suggest the claim limitations “means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” and “logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” as recited in claim 20. The final Office Action alleged that *Nielson* teaches the “means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database”

limitation. Applicants respectfully disagree. It is not clear from the *Nielson* reference what occurs in “response to” the “inherent” entry input, nor what prompts steps 501 and 503.

With regard to the limitation of claim 20, “wherein the contacts database is stored within memory of the sending device,” Applicants respectfully submit that the combination of *Nielson* and *Reilly* is improper in that such a combination would render the invention in *Nielson* unsatisfactory for its intended purpose. Maintaining the database of *Nielson* at each sending device would cause error messages to occur when email addresses are changed, creating the very problem the invention in *Nielson* sought to address.

With regard to the “automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved” limitation, Applicants respectfully submit that this limitation is not disclosed, taught, or suggested in the combined references. Step 507 provides, with emphasis added, “the method adds the recipient’s **new email address** to the address book.” (See col. 7, lines 20-21) The new email address is not **the** sending information entered at the sending device. Thus, according to the explicit limitations in claim 20, the sending information entered at the sending device must be what is automatically cached. The invention disclosed in *Nielson* does not teach this feature.

Thus, since neither *Nielson* nor *Reilly* disclose, teach, or suggest the claim limitations “means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database,” “wherein the contacts database is stored within memory of the sending device,” or “logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved,” Applicants respectfully request that the rejection to claim 20 be withdrawn.

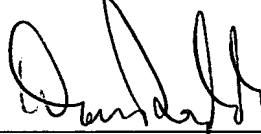
Applicants also submit that since independent claim 20 is allowable, dependent claims 21-24, which contain the limitations of independent claim 20, are allowable as a matter of law.

CONCLUSION

Based upon the foregoing discussion, Applicants respectfully request that the Examiner's final rejection of claims 1, 5-10, 12-24, and 30 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

Please charge Hewlett-Packard Company's deposit account 08-2025 in the amount of \$330.00 for the filing of this Appeal Brief. No additional fees are believed to be due in connection with this Appeal Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 08-2025.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David Rodack', is written over a horizontal line.

David Rodack
Registration No. 47,034

(770) 933-9500

VIII. CLAIMS - APPENDIX

1. (Previously Presented) A method for processing sending information in a sending device, comprising:

receiving an entry input by a user at the sending device, the entry comprising sending information that identifies a destination to which information is to be sent by the sending device;

responsive to the entry, cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the contacts database, wherein the contacts database is stored within memory of the sending device; and

automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

2-4. (Canceled).

5. (Previously presented) The method of claim 1, further comprising providing previously saved sending information to the user if it matches sending information entered by the user.

6. (Previously presented) The method of claim 5, wherein the previously saved sending information was automatically cached by the device.

7. (Previously presented) The method of claim 1, wherein the sending device is a digital sender capable of emailing and faxing hardcopy documents.

8. (Original) The method of claim 1, further comprising receiving a plurality of destination addresses/numbers and cross-referencing the addresses/numbers to see if a distribution list containing each is saved for the user.

9. (Previously presented) A method for processing sending information in a sending device, comprising:

- receiving an entry input by a user at the sending device, the entry comprising sending information, and determining the identity of the user from the entry;

- receiving the sending information entered by the user that identifies a destination to which information is to be sent by the sending device;

- responsive to the entry, cross-referencing the sending information entered by the user with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved for that user, wherein the contacts database is stored within memory of the sending device;

- providing previously saved sending information to the user as a selection option if sending information entered by the user matches the previously saved sending information; and

- automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

10. (Previously presented) The method of claim 9, wherein receiving an entry input by a user at the sending device comprises receiving log in information.

11. (Canceled)
12. (Previously presented) The method of claim 9, wherein the previously saved sending information was automatically cached by the device.
13. (Original) The method of claim 9, wherein the sending device is a digital sender capable of emailing and faxing hardcopy documents.
14. (Original) The method of claim 9, further comprising receiving a plurality of destination addresses/numbers and cross-referencing the addresses/numbers to see if a distribution list containing each is saved for the user.
15. (Previously Presented) A sending information processing system, comprising:
 - logic configured to receive sending information entered by a user at a sending device that identifies a destination to which electrical information is to be sent;
 - logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved for that user in the database, wherein the contacts database is stored within memory of the sending device; and
 - logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

16. (Previously presented) The system of claim 15, further comprising logic configured to provide previously saved sending information to the user if it matches user-entered sending information.

17. (Previously presented) The system of claim 16, wherein the previously saved sending information is obtained from the contacts database.

18. (Original) The system of claim 15, wherein the sending device is a digital sender capable of emailing and faxing hardcopy documents.

19. (Original) The system of claim 15, comprising logic configured to receive a plurality of destination addresses/numbers and cross-referencing the addresses/numbers to see if a distribution list containing each is saved for the user.

20. (Previously Presented) A sending information processing system, comprising:
means for receiving through entry by a user at a sending device sending information that indicates a destination to which information is to be sent;

means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the database for that user, wherein the contacts database is stored within memory of the sending device; and

means for automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

21. (Previously presented) The system of claim 20, further comprising means for providing previously saved sending information to the user if it matches sending information entered by the user.

22. (Previously presented) The system of claim 21, wherein the previously saved sending information is obtained from the contacts database.

23. (Original) The system of claim 20, wherein the sending device is a digital sender capable of emailing and faxing hardcopy documents.

24. (Original) The system of claim 20, comprising logic configured to receive a plurality of destination addresses/numbers and cross-referencing the addresses/numbers to see if a distribution list containing each is saved for the user.

25-29. (Canceled)

30. (Previously presented) The method of claim 1, further comprising, prior to receiving an entry input by the user, determining an identity of the user.

Henry, et al.
Ser. No. 09/576,093

IX. EVIDENCE - APPENDIX

None.

IX. RELATED PROCEEDINGS- APPENDIX

None.